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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,146	12/23/2003	Hitoshi Matsuoka	1691-0195P	7474
2292 7590 05/17/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER DOVE, TRACY MAE	
			ART UNIT 1745	PAPER NUMBER
			NOTIFICATION DATE 05/17/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.		Applicant(s)	
	10/743,146		MATSUOKA ET AL.	
	Examiner		Art Unit	
	Tracy Dove		1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the communication filed on 3/7/07. Applicant's arguments have been considered, but are not persuasive. Claims 1 and 3-20 are pending. Claims 3 and 4 are withdrawn. This Action is made FINAL, as necessitated by amendment.

Election/Restrictions

Applicant requested nonelected Group II be rejoined with Group I. Group II will be considered for rejoinder only if all claims in elected Group I are directed toward allowable subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-14 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al., US 6,465,136.

Fenton teaches a composite membrane structure comprising a composite membrane and at least one protective layer disposed adjacent to the composite membrane. The composite membrane is a porous polymeric matrix (porous film) and an ionically conductive solid, noble metal or combination thereof dispersed within the matrix, and preferably, a binder. The binder is an ion exchange polymer. The protective layer comprises binder and ionically conductive solid, hygroscopic fine powder or a combination thereof (abstract). The porous polymeric matrix possesses high porosity and extremely fine pore size. Preferably the matrix has pores possessing

a maximum dimension in the range from about 0.025 μm to about 1 μm . (4:66-5:13). The ionically conductive solid and binder are impregnated into the porous polymeric matrix in order to render the interior volume of the membrane occlusive (33-39). The binder is preferably present in the composite membrane and is any chemically and electrochemically stable ion exchange resin or other polymer with high ionic conductivity (6:19-29). The protective layer comprises a binder and hygroscopic fine powder. The fine powders may be silica or titania and have an average particle size less than about 10 μm (6:61-67). The binder employed in the protective layer may be the same as that employed in the composite membrane (6:40-60). The matrix has porosity in the range of 40-95%, more preferably 60-90% (5:14-20). The matrix has a thickness of 6-102 μm (4:55-65). The binder and ionically conductive solid employed in the protective layer are the same types of materials as those dispersed within the composite membrane (continuous phase) (6:50-54). Noble metals (inorganic filler) can be used in addition to the ionically conductive solid in the composite membrane (6:7-18).

Fenton does not explicitly teach fine powders having an aspect ratio of 50 to 2000.

However, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because the courts have held that where the only difference between the prior art and the claimed invention was a recitation of relative dimensions (particle size or aspect ratio) of the claimed device (composite membrane) and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See MPEP 2144.04.

Regarding claims 10 and 11, one of skill would have known that the composite membrane with protective layer of Fenton and the ion exchange membrane of the claimed invention would have had similar properties.

*

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fenton et al., US 6,465,136 in view of Roark et al., US 7,001,446.

See discussion of Fenton above regarding claim 1. Fenton does not explicitly teach the fine particles are selected from the materials of pending claim 15.

However, Roark teaches a protective layer is applied to a membrane to protect the catalyst from the detrimental effects of feedstream and other contaminants that may enter the membrane. Exemplary protective layers include alumina, zirconia and other metal oxides. A protective layer of porous perovskites can be used to protect the membrane from poisoning. In addition, a protective layer comprising a ceramic or other material that absorbs water or hydrocarbons can be provided (9:57-10:16).

Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one of skill would have been motivated to use the perovskite protective layer material of Roark for the protective layer of Fenton because Fenton teaches useful powders for the protective layer are those which are capable of absorbing water. The protective layer of Fenton decreased the amount of fuel crossover and the protective layer of Roark prevents the feedstream and contaminants from passing through to the membrane. Therefore, one of skill would have been motivated to use the protective layer materials of Roark for the protective layer of Fenton to decrease fuel (feedstream) crossover.

Response to Arguments

Applicant's arguments filed 3/7/07 have been fully considered but they are not persuasive.

Applicant argues Fenton does not teach or suggest a lamellar particle having an aspect ratio of 50-2000. However, the invention would have been obvious to one of skill in the art because the courts have held that where the only difference between the prior art and the claimed invention was a recitation of relative dimensions (particle size or aspect ratio) of the claimed device (composite membrane) and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See MPEP 2144.04.

Applicant asserts unexpected results are shown in the Examples of the specification. However, the Examples are not representative of the Fenton reference. Unexpected results must distinguish the claimed invention over *the prior art of record*. Furthermore, the Examples are not commensurate in scope with the claimed invention because at least claim 1 does not require a fuel cell wherein methanol is supplied as an anode reactant gas.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 11, 2007


TRACY DOVE
PRIMARY EXAMINER